REMARKS/ARGUMENTS

1.)   Claim Amendments

The Applicant has amended claim 29; no new subject matter has been added. Claims 24-27 and 29-46 remain pending in the application.

2.)   Examiner Objections - Claims

The Examiner objected to claim 29 as being dependent upon a cancelled claim. The Applicants have amended claim 29 to correct the error; claim 29 is now dependent from claim 24.

3.)   Claim Rejections – 35 U.S.C. §101 / §112

The Examiner has maintained the rejection of claims 24-27, and 29-40 on the asserted basis that those claims are directed to "non-statutory subject matter and found indefinite." The Applicants, again, traverse the rejections.

In the prior office action, the Examiner rejected the claims under §101 on the asserted basis that the claims recite "means for" claims limitations without "integrating a machine (e.g., a computer)." In addition, the Examiner rejected the claims under §112 on the asserted basis that they recite "means for" claim elements with no structure disclosed in the specification. In response, the Applicants noted that the functions performed by the various "means for" elements, as authorized under §112, Paragraph 6, are disclosed as being performed by conventional telecommunications network elements known to those skilled in the art as various general or specific-purpose computers. In maintaining the rejections under §§101 and 112, the Examiner is conflating the principles enunciated by the Federal Circuit and U.S. Supreme Court in the cases of *Cominsky*, *Bilski* and *Biomedino*.

First, claims 24-27 and 29-40 are directed to statutory subject matter. Each of those claims is directed to an apparatus wherein certain "means for" performing each of a novel combination of functions are performed. Not only do the claim preambles limit the claims to an apparatus, but such "means for" elements are statutorily authorized under §112, ¶6: "An element in a claim for a combination may be expressed as a

means . . . for performing a specified function <u>without the recital of structure</u> . . . , and such claim shall be construed to cover the corresponding structure . . . . described in the specification and equivalents thereof." (emphasis added) The functions recited in those claims are identified in the specification as being performed by various network nodes, including a "Secure Service Entry Point" and a "Single Sign-On server," which are, in fact, explicitly recited in the claims. Neither *In re Comisky* or *In re Bilski* were concerned with the question of whether claims drafted in accordance with §112, ¶6, qualified as statutory subject matter. In fact, it would be incongruous to the patent statute, as a whole, to state that claims can be drafted using the statutorily-authorized form under §112, ¶6, yet not qualify as statutory subject matter under §101.

The foregoing is also supported by the Federal Circuit's opinion in *Biomedino*, in which the court stated that:

> Once a court concludes that a claim limitation is a means-plus-function limitation, two steps of claim construction remain: 1) the court must first identify the function of the limitation; and 2) the court must then look to the specification and identify the corresponding structure for that function. If there is no structure in the specification corresponding to the means-plus function limitation in the claims, the claim will be found invalid as indefinite. <u>While the specification must contain structure linked to claimed means, **this is not a high bar**: "[a]ll one needs to do in order to obtain the benefit of [§ 112, ¶ 6] is to recite *some* structure corresponding to the means in the specification, as the statute states, so that one can readily ascertain what the claim means</u> and comply with the particularity requirement of [§ 112,] ¶ 2." Additionally, interpretation of what is disclosed in the specification must be made in light of the knowledge of one skilled in the art. Thus, in order for a means-plus-function claim to be valid under § 112, the corresponding structure of the limitation "must be disclosed in the written description in such a manner that one skilled in the art will know and understand what structure corresponds to the means limitation. Otherwise, one does not know what the claim means." (emphasis added)

One of ordinary skill in the art would readily ascertain, from a reading of Applicants' specification, the means necessary to carry out the recited claim functions using the telecommunications nodes and elements clearly depicted in the figures and described with reference thereto. Accordingly, claims 24-27, and 29-40 satisfy the requirements of §§101 and 112.

4.)   Claim Rejections – 35 U.S.C. §103(a)

The Examiner has rejected claims 24-27, 29-30, 37, and 41-45 as being unpatentable over Jin, *et al.* (U.S. Patent No. 6,643,782) in view of Montenegro (U.S. Patent No. 6,571,289); and claims 31-36, 38-40 and 46 as being unpatentable over Jin in view of Montenegro and Schneider, *et al.* (U.S. Patent No. 6,105,027). The Applicants traverse the rejections.

In the present office action, the Examiner has not provided any substantive response to the arguments present by Applicants in response to the prior office action. The Examiner *again* <u>acknowledges</u> that Jin does not disclose establishing a secure tunnel by using an outer IP address assigned to the user by the access network for addressing the user, and by using the internal IP address assigned to identify the user in the service network as an inner IP address in the tunneled traffic. Furthermore, the Examiner's withdrawal of the §102 rejection of claim 37, which he has now rejected under §103, is a tacit acknowledgement that claim 37 is novel in view of the teachings of Jin. As previously argued by Applicants, Montenegro fails to overcome the deficiencies of Jin and, therefore, claims 24-27 and 29-46 are not obvious in view of those references, or further in view of Schneider.

Montenegro discloses a plurality of tunnel segments composing a chain of a registration request from a mobile node to a private network. More particularly, Montenegro discloses (see: column 4, lines 14-36) that when a correspondent node, whose address is CN, desires to send a packet of information to a mobile node, whose address is MN, in a private network, the correspondent node will compose a packet with a source address of CN and a destination address of MN. This packet is intercepted by a Home Agent in the private network, whose address is HA, and the Home Agent forwards such packet to a Gateway, whose address is GW, by pre-pending an additional header with a source address of HA and a destination address of GW. The Gateway receives such packet and strips off the added header to recover the original packet with source address of CN and destination address of MN, and encounters that such MN address has a binding in the GW with an address of a Foreign Agent, whose

address is FA. This binding makes the Gateway prepend (*i.e.*, prefix) its own new header with source address of GW and destination address of FA. The Foreign Agent receiving such packet also strips off the latest header and recovers the original packet with source address of CN and destination address of MN. From this teaching in Montenegro, it can be seen that the original packet has a unique header with a source address of CN and a destination address of MN when submitted between the correspondent node and the Home Agent as well as when submitted between the Foreign Agent and the mobile node in the private network; and the original packet has an additional header prepended to the original packet, with source address of HA and a destination address of GW, when submitted between the Home Agent and the Gateway, and another additional header pre-pended to the original packet, with source address of GW and a destination address of FA, when submitted between the Gateway and the Foreign Agent. In other words, Montenegro discloses more than one source address and more than one destination address for a same unique packet, wherein the more than one source address and wherein the more than one destination address always correspond to ***different*** entities.

Montenegro thus fails to anticipate two different IP addresses corresponding to the *same* entity accompanying the packet and used for different purposes. More specifically, Montenegro fails to disclose an *outer* IP address assigned to the user by the access network for addressing the user and an *internal* IP address assigned to identify the user in the service network as an inner IP address in the tunneled traffic. Therefore, even if disclosing secure tunnels, **Montenegro fails to teach means for establishing a secure tunnel with a user from a Secure Service Entry Point when receiving access credentials through an access network by using an outer IP address assigned to the user by the access network for addressing the user, and by using the internal IP address assigned to identify the user in the service network as an inner IP address in the tunneled traffic**.

Accordingly, claim 24 is not obvious over Jin in view of Montenegro. Similarly, whereas claims 37 and 41 recite analogous limitations, they are also not obvious. Furthermore, whereas claims 25-27 and 29-36 are dependent from claim 24, claims 38-

40 are dependent from claim 37, and claims 42-46 are dependent from claim 41, and include the limitations of their respective base claims, they are also not obvious in view of the cited references.

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CONCLUSION

In view of the foregoing amendments and remarks, the Applicants believe all of the claims currently pending in the Application to be in a condition for allowance. The Applicants, therefore, respectfully request that the Examiner withdraw all objections/rejections and issue a Notice of Allowance for claims 24-27 and 29-46.

The Applicants request a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,
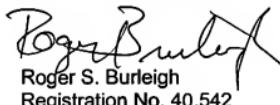
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